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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,856	02/08/2002	Takafumi Sakamoto	0171-0817P	9661
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BIRCH STEWART KOLASCH & BIRCH				
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EXAMINER				
ZIMMER, MARC S				
ART UNIT		PAPER NUMBER		
1712				

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/067,856

Applicant(s)

SAKAMOTO ET AL.

Examiner

Marc S. Zimmer

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 4-6.Claim(s) rejected: 1-2, 7-10.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

It is Applicant's position that the Examiner has applied the wrong standard in assessing the usefulness of the Declaration originally filed July 2, 3003. That is, Applicant suggests that the Examiner has required a comparison of their invention against an invention that does not constitute the closest prior art available. Specifically, Applicant alleges that the closest prior art taught by the combination of *Iwahara* and *Kimura* is that wherein the plasticizer, corresponding to component (D) of the present invention, is polybutene. The Examiner vehemently disagrees.

It is clearly stated in the rejection made final and mailed on August 13, 2003 that Iwahara teaches chlorinated paraffins as one embodiment of the plasticizer in column 14, line 5 of the primary reference whereas Applicant claims a genus of compounds delineated as "paraffin process oil". It will be appreciated by one of ordinary skill that chlorinated paraffins are a member of this genus insofar as the original disclosure does not particularly exclude the chlorinated congeners. The Examiner has conceded that the reference does not expressly describe the physical state of the chlorinated paraffin, i.e. that it is an oil. Nonetheless, it has been asserted on record that the chlorinated paraffin is inherently an oil given it's intended role within the composition taught by Iwahara. Notably, Applicant has not disputed this idea in their response. Indeed, it appears that Applicant has completely ignored the Examiner's statements regarding Iwahara's use of chlorinated paraffin as a plasticizer.

In view of the clear anticipation of component (D) of the instant invention by the primary reference, Applicant's declaration would seem to have little probative value as a means of overcoming the standing rejection under 35 U.S.C. 103.

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The remainder of Applicant's arguments are precisely the same as those offered in Applicant's response dated July 2, 2003, albeit in a different order. Insofar as these matters have already been adequately addressed during the prosecution of this case, they deserve no further comment at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

December 2, 2003


MARGARET G. MOORE
PRIMARY PATENT EXAMINER
ART UNIT 1712